

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TADASHI FUJII

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Appeal No. 1998-2578  
Application No. 08/443,307

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ON BRIEF

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Before BARRETT, DIXON, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

This is a decision on the Examiner's Request for Rehearing, mailed May 22, 2001 (Paper No. 18), of our decision mailed January 10, 2001 (Paper No. 17), wherein we reversed the rejection of claims 1-23.

We grant the request for rehearing, reverse our earlier decision, and affirm the rejection of claims 1-23.

OPINION

The Examiner, in the Request for Rehearing, submits that the Board erred in finding there was no “multiple screen construction means,” as recited in claim 1, in the Figure 3 embodiment of U.S. Patent No. 4,218,710 (Kashigi). The Examiner states that the rejection relied upon the Figure 5 embodiment of Kashigi.

In our earlier opinion (at 9), we interpreted the “multiple-screen construction means” of claim 1 as combining multiple full screens for simultaneous display, whereas we found, based on the Figure 3 embodiment, that Kashigi only taught combining partial or split screens together to make a single screen containing halves or quarters of each of the two or four screens. However, the Examiner is correct that the rejection relied on Figure 5.

We agree with the Examiner that Kashigi’s Figure 5 embodiment combines multiple full screens for simultaneous display. Kashigi states at col. 9, ll. 15-20:

Referring more specifically to FIG. 5, let it be assumed that it is wished to compress first through fourth pictures to be represented by the respective ones of the first through the fourth input television signals **11**, **12**, **128**, and **129** to a half on a linear scale and to combine the compressed pictures into a composed picture.

The reference thus describes receiving four video signals through inputs 11, 12, 128, 129 (Fig. 5), and compressing each of the signals to one-half original size, yielding a composed picture made up of compressed versions of the four original pictures. The

composed picture is stored to “one-frame memory and read-side device” 73.<sup>1</sup> Kashigi goes on to detail, in columns 9 and 10, how the multiple pictures may be compressed and then arranged for display. “[T]he first through the fourth compressed pictures should be positioned in top left, top right, bottom left, and bottom right quarter areas P, Q, R, and S (not shown), respectively, of the composed picture.” Id. at col. 10, ll. 24-27. We note that Kashigi’s description of the “composed picture” appears substantially identical to the 2 x 2 “multiple-screen arrangement” illustrated in appellant’s Figures 2a and 2b, and described at pages 9 through 10 of the specification.

Appellant’s only point of contention in the Supplemental Reply to Examiner’s Request for Rehearing (“Appellant’s Reply”), filed Aug. 9, 2001, is based on the allegation that the Examiner has not made out a case of prima facie obviousness because the Examiner has failed to “adequately explain or show exactly where Kashigi specifically and operatively teaches how memory 80 (or any other memory for that matter in Kashigi), stores image data in an arrangement in the memory that is capable of constructing multiple screens.” (Appellant’s Reply at 5.) We rely on the Examiner’s findings and reasoning in the Answer and in the Request for Rehearing, and our original decision, for the other claim limitations.

Since Kashigi discloses that the composed picture output is made up of (four) multiple screens, we do not see how Kashigi might fail to disclose that the image data is

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<sup>1</sup> As the Examiner notes (Request for Rehearing at 10), element 73 is mislabeled in Figure 5 as a “write-side” device.

stored in an arrangement that is “capable of” constructing multiple screens. The image memory in Kashigi is not only “capable of,” but does, store multiple screens in the same sense as Appellant’s display memory 20 stores multiple screens.

Memory 80, as shown in Figure 5, is a four-line (four horizontal scanning lines) buffer memory, comprised of four one-line memories 91, 92, 93, and 94 (Fig. 4). See Kashigi at col. 6, ll. 22-28; col. 7, ll. 16-24. The “one-frame memory and read-side device” 73 shown in Figure 5 is more fully described in the disclosure of the Figure 3 embodiment, and with circuit details shown in Figure 3. The device contains a one-frame memory 30 which, in the Figure 3 embodiment, is filled with image data in a sequence controlled by selector device 76. Splitting first and second input television signals along a vertical line of each picture, and combining the split pictures into a composed picture, is described at the paragraph bridging columns 6 and 7.

The Figure 5 embodiment uses selector device 136 for filling one-frame memory 30, contained within device 73. As further described at column 11, lines 3 through 34 of Kashigi, one-frame memory 30 is filled with digital image data comprised of pulse code modulated data codes 88, which are multiplexed through contacts A, B, C, and D. The one-frame memory 30 is thus filled in a piecemeal fashion from smaller memory 80 contained in each of the “write-side” devices 131, 132, 133, and 134, each of the “write-side” devices corresponding to a separate input (11, 12, 128, 129) to the system.

According to appellant's specification (at pages 6 through 11), display memory 20 is loaded with image data from buffer memory 19. The image data is stored in display memory 20, as reflected in the claims, "in an arrangement capable of constructing multiple screens." The image data in the Kashigi device is stored in one-frame memory 30 "in an arrangement capable of constructing multiple screens." The image data is converted to analog form by means of D/A converter 57 (Fig. 3), processed through low pass filter 59, and available for display at output 14. In the described Figure 5 embodiment, the output consists of a display composed of (four) multiple full screens.

We are thus unpersuaded that Kashigi fails to teach the feature alleged by appellant to be absent. To the extent that appellant may be arguing that the claim recitation of "capable of constructing multiple screens" captures disclosed process steps that are unexpressed in the instant claims, we decline to read unrecited limitations into the claims. Claims are to be given their broadest reasonable interpretation during prosecution, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969).

There is no evidence in the record that the word "constructing" has any special meaning to the artisan. Nor do we find any particular definition of the word in the

instant specification. See In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (repeating the principle that where an inventor chooses to be his own lexicographer and gives terms uncommon meanings, he must set out the uncommon definition in the patent disclosure). See also Beachcombers Int'l, Inc. v. WildeWood Creative Prods., Inc., 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994) ("As we have repeatedly said, a patentee can be his own lexicographer provided the patentee's definition, to the extent it differs from the conventional definition, is clearly set forth in the specification."); Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999) (there is a "heavy presumption" that claim language has its ordinary meaning).

We thus interpret the word "constructing" in accordance with the ordinary meaning of its transitive verb form: "to make or form by combining or arranging parts or elements," or "to set in logical order." See Webster's Ninth New Collegiate Dictionary (1990 ed.). The broadest reasonable interpretation of storing image data in an image memory "in an arrangement capable of constructing multiple screens" thus requires no more than the storing of image data in an image memory as taught by Kashigi.

Appellant, at pages 3 through 5 of Appellant's Reply, submits arguments concerning "compositing" and the "interpolation schemes" for compressing images as disclosed by Kashigi. To the extent that appellant may be arguing that the image compression, as described at column 9, line 15 through column 10, line 22 of Kashigi, does not teach the feature of storing image data in an arrangement that is "capable of

constructing multiple screens,” we agree. However, consistent with the instant invention as disclosed and claimed, Kashigi’s compression of images is an operation distinct from that of storing image data to one-frame memory 30.

We thus find none of appellant’s arguments to be persuasive.

We note that independent claim 1 is drawn to an image processing apparatus and drafted in “means plus function” format, independent claim 2 is drawn to an image processing method, and independent claim 3 is drawn to an image processing apparatus. In the Brief (at 4) appellant submits that claims 1-23 stand or fall together, and does not argue the limitations of any particular claim in the accompanying arguments section. In our original decision we chose claim 1 as representative of the invention. However, in neither the original Brief nor in Appellant’s Reply does appellant argue that, with respect to claim 1, prior art structures are not equivalents of the disclosed structures corresponding to claimed elements, in the sense of 35 U.S.C. § 112, sixth paragraph, equivalents. Nor was our original decision, reversing the rejection of claims 1-23, based on section 112, sixth paragraph, considerations. Appellant instead relies on the argument that the function of storing image data in an arrangement capable of constructing multiple screens is not disclosed or suggested by the prior art. We therefore consider it unnecessary, more than four years after appellant’s filing of the appeal in this case, to remand the application to the Examiner for any sort of “equivalents” analysis. We interpret the unambiguous terms of the claims as we find them.

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In summary, we have granted the Examiner's request for rehearing, and have determined that our original decision was in error. We sustain the rejection of claims 1-23 under 35 U.S.C. § 103 as being unpatentable over Kashigi, Pietzsch, Gelissen, and Maietta. We have considered all of appellant's arguments in making our determinations. Arguments not relied upon are deemed waived. See 37 CFR § 1.192(a) ("Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.") and § 1.192(c)(8)(iv) (the brief must point out the errors in the rejection).

#### CONCLUSION

The Examiner's request for rehearing is granted. We reverse our decision of January 10, 2001. The Examiner's decision in rejecting claims 1-23 is affirmed.

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No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a).

GRANTED -- AFFIRMED

LEE E. BARRETT	)	
Administrative Patent Judge	)	
	)	BOARD OF PATENT
	)	APPEALS AND
	)	INTERFERENCES
	)	
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

HBB:clm

DIXON, Administrative Patent Judge, dissenting:

I DISSENT from the majority's reversal of our original decision.

I find that the present record is not adequate to make an appropriate determination on the Request for Rehearing by the examiner and the issues involved at this time. I would REMAND the application to the examiner in response to the Supplemental Reply to the Examiner's Request for Rehearing filed Aug. 9, 2001 to further consider Appellant's arguments providing responses thereto and to make specific findings with respect to the examiner's interpretation of the claim limitation:

multiple-screen construction means for storing image data, which has been provided by a designated storage medium or image signal generating source and converted by one of said plurality of said image signal processing means, or reduced image data reduced by said image reduction means, in said image memory in an arrangement capable of constructing multiple screens.

Specifically, has the examiner (1) interpreted the use of alternative claim language to require only image data "reduced image data reduced by said image reduction means;" (2) has the examiner made a determination that the appellant is or is not attempting to invoke an interpretation of the "multiple-screen construction means" under 35 U.S.C. § 112, sixth paragraph; (3) if appellant has invoked 35 U.S.C. § 112, sixth paragraph by reciting the limitation in "means plus function" format, is there an identity of function being claimed or an equivalent, and to provide specific findings with regard to the corresponding structure and acts disclosed in the specification. See MPEP 2181

et seq. ( Rev. 1, Feb. 2000).<sup>2</sup> The MPEP sets forth a 3-prong analysis for determining if a claim limitation will be interpreted to invoke 35 U.S.C. § 112, sixth paragraph. Here, I find nowhere in the record, including the Request for Rehearing, that the examiner has done the required analysis or made a finding that the sixth paragraph does not apply to the instant claim language. Next, the MPEP at page 2100-160 sets forth the procedures of determining if the written description adequately describes the corresponding structure, materials or acts necessary to support a limitation which invokes 35 U.S.C. § 112, sixth paragraph. Here, I find nowhere in the record, including the Request for Rehearing, that the examiner has done the required analysis or made a finding that the sixth paragraph does not apply to the instant claim language due to a lack of correspondence to the disclosed structure and acts. MPEP 2183 at page 2100-162 sets forth "Making a *Prima Facie* Case of Equivalence" which states the "[i]f the examiner finds that a prior art element performs the function specified in the claim, . . . the examiner should infer from that prior art element is an equivalent . . . [t]he burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure, material or act disclosed in the application. Here, I

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<sup>2</sup> A copy is attached to this decision. At the time of the filing of the decision and the Request for Rehearing by the examiner, the MPEP sets forth the requisite procedure and findings to be made by an examiner. MPEP 2181 at pages 2100-158 quotes **In re Donaldson**, 16 F.3d 1189, [1194-95,] 29 USPQ2d 1845, [1850] (Fed. Cir. 1994) "[p]er our holding, the 'broadest reasonable interpretation' that an examiner may give mean-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination."

find nowhere in the record, including the Request for Rehearing, that the examiner has done the required analysis or made a finding that the structure or acts disclosed by Kashigi in Figure 5 is an equivalent to the:

multiple-screen construction means for storing image data, . . . , in said image memory in an arrangement capable of constructing multiple screens.

Since the examiner has not addressed the sole limitation in dispute in the manner consistent with the required procedures set forth by the Office at the time of the decision and at the time of the mailing of the Request for Rehearing, I would remand the application to the examiner to make the specific findings needed so that we, the Board, may review the *prima facie* case.

Additionally, the examiner's response (Paper No. 22), mailed Sep. 5, 2001, to appellant's Supplemental Reply (Paper No. 21), filed Aug. 9, 2001, merely states that the paper has been considered and entered. From our review of appellant's reply, we note that appellant argues that "the passages relied on by the Examiner say nothing of substance, in any respect (notwithstanding the Examiner's discourse bridging pages 8-10 of the Rehearing Request) regarding how image data is stored in a particular arrangement so that it would facilitate the construction of multiple screens, as amply described in the specification of the present invention." (See Supplemental Reply at page 4.) The main limitations in independent claim 1 at issue are drafted in means-plus-function format (multiple-screen construction means and image signal output means). While the examiner has generally identified the corresponding

structures from the drawings in the Request for Rehearing at page 5, the examiner has not interpreted the claim limitations in light of 35 U.S.C. § 112, sixth paragraph.

I interpret appellant's argument referencing the specification and disclosed invention to be an argument with respect to 35 U.S.C. § 112, sixth paragraph, as to the appropriate interpretation of the recited means-plus-function limitation(s) as mandated by the statute and clarified by **Donaldson**. As discussed above, I find that the examiner has not made factual findings in the record that (1) Kashigi performs the "equivalent" function; and (2) the function of Kashigi is performed in the same manner as disclosed. Therefore, I would remand the case to the examiner to make any appropriate factual findings and claim interpretations as deemed appropriate in light of appellant's arguments in the Supplemental Reply.

The majority at page 7 indicates that appellant has not made a showing that the prior art structures are "not equivalents." I view this as "putting the cart before the wagon" and improperly shifting the burden before the examiner has met the initial burden. While the MPEP is clear that "[i]f the examiner finds . . . the prior art element is an equivalent" then the examiner concludes anticipation of the claimed limitation, but the MPEP does not state that the examiner must communicate this finding to appellant. I view it as a given that any "FINDING" of the examiner must be stated in the record or it is not a finding, either factual or legal. In the present record, I neither find a clear finding by the examiner nor do I find such a clear finding by the majority upon which a decision may be made. The majority, at pages 3 and 4, state that "we do not see how

Kashigi might fail to disclose that the image data is stored in an arrangement that is 'capable of' constructing multiple screens. The image memory in Kashigi is not only 'capable of,' but does, store multiple screens." From my understanding of the invention, it is not the image memory performing recited function, but the image memory is the recipient of the resultant data from the "multiple-screen construction means." The majority focuses exclusively on the function as recited after the "means for" but the limitation is a compound limitation also having functional language recited before the "means for" limitation.

The majority finds no evidence in the record of the word "constructing" has special meaning to the artisan and they give it its ordinary meaning. I agree with the majority that both "constructing" and "construction" should be given their ordinary meaning. Furthermore, I find that neither the majority nor the examiner has considered the "multiple-screen construction means" portion of the claim limitation, and has not addressed the "construction" of the data as disclosed in appellant's specification at pages 9-13 and Figures 4(a) and 4(b) which discusses the user interface to select from the multiple screen arrangements and image processing to simultaneously display the multiple images on the screen in the selected arrangement.

The majority at pages 7 and 8 raises the point that independent claim 2 (and independent claim 3) does not contain 35 U.S.C. § 112, sixth paragraph issues. While this issue is immaterial to the rehearing of our decision based on claim 1, the majority finds that "Appellant instead relies on the argument that the function of storing image

data . . . is not disclosed or suggested by the prior art." Again, neither the majority nor the examiner has addressed appellant's argument at page 4 of the Reply concerning the "multiple screen construction means." [Emphasis added.] Additionally, I would agree with the majority as to the appropriate disposition of those claims, as grouped by appellant, if the case did not already have a decision based upon independent claim 1, which we now consider on rehearing.

The majority goes on to interpret the unambiguous terms in the claims as they find them without consideration to their usage in the specification. The terms "constructing," "constructed," and "constructs" are throughout the specification and appear to be used in their ordinary meaning. (See specification at pages 2, 3, 7, 9 and 10.) For example, page 9 of the specification states "[t]he image data for constructing the multiple screens is created in the display memory 20" and page 10 of the specification states "transfer of image data from the buffer memory 19 to the display memory 20 (which includes determining addresses so as to construct multiple screens) and image reduction processing are executed by the CPU 16." Throughout the specification, the term "construct" and "construction" are used to consistently refer to a process or act of forming and placing data in the designated locations in a partitioned memory. From my understanding of the disclosed invention and the claimed invention, I would interpret the

multiple-screen construction means for storing image data, . . . , in said image memory in an arrangement capable of constructing multiple screens [emphasis added]

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as the disclosed structure and process which constructs the data in an arrangement to be stored in the image memory for output to the display, and not the memory or step of storing the constructed data in the memory. This would be my finding, it may be different from the examiner's finding or the majority's finding, but we have neither in the record. Therefore, I would remand the case.

JOSEPH L. DIXON  
Administrative Patent Judge

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